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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/539,269	03/30/2000	Stephen R. Hanna	SUN-p4324-RSH	8981

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EXAMINER
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ENGLAND, DAVID E

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/539,269

Applicant(s)

HANNA ET AL

Examiner

David E. England

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 - 7, 9 - 17, 19 - 27, 29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 7, 9 - 17, 19 - 27, 29 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1 – 7, 9 – 17, 19 – 27, 29 and 30 are presented for examination.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 – 5, 9 – 15, 19 – 25, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold (6275848) in view of what is well known in the art in further view of Beck et al. (5903723) (hereinafter Beck) in further view of Young et al. (6243466) (hereinafter Young) in further view of Eldridge et al. (6397261) (hereinafter Eldridge).
4. Referencing claim 1, as closely interpreted by the Examiner, Arnold teaches a method for replacing an attachment to an email message with a reference to a location of the attachment, comprising:
  5. receiving the email message, (e.g. col. 1, lines 13 – 25);
  6. examining the email message to determine if the email message includes an attachment, (e.g. col. 2, lines 20 – 60); and
  7. if the email message includes the attachment,
  8. storing the attachment at a location on a communication network from which the attachment can be retrieved, (e.g. col. 2, lines 20 – 50),

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9. modifying the email message by replacing the attachment with a reference specifying the location of the attachment on the communication network, (e.g. col. 2, lines 20 – 50),
10. sending the modified email message to a recipient of the email message, (e.g. col. 2, lines 20 – 50),
11. providing proof of receipt of the contents of the attachment, (e.g. col. 4, line 25 – col. 5, line 6, “*preferably only the originator of the message and the intended recipients have access to the access list, and preferably the only operation recipients may do is delete themselves from the list.*”), and
12. deleting the attachment from the location on the communication network after on of:
13. receiving a notification that all recipients of the email message have retrieved the attachment, (e.g. col. 4, line 25 – col. 5, line 56), but does not specifically teach
14. asking a sender of the email message whether to replace the attachment with a reference specifying the location of the attachment;
15. receiving a notification that all recipients of the email message have deleted the email message; wherein providing proof of receipt involves:
16. delivering an encrypted version of the attachment,
17. receiving a receipt for the encrypted version of the attachment, wherein the receipt includes a hash of the encrypted attachment, and
18. sending the decryption key for the attachment.
19. Official Notice is taken that it was a common practice to receiving a notification that all recipients of the email message have deleted the email message at the time the instant invention was made.

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20. It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the method disclosed by Arnold to receiving a notification that all recipients of the email message have deleted the email message using the teaching of common practice. The modification would be obvious because one of ordinary skill in the art would be motivated to receiving a notification that all recipients of the email message have deleted the email message because in conventional e-mail systems when an e-mail with an attachment is deleted the attachment attached to the e-mail is deleted with the e-mail. If a user or a group of users desire to delete an e-mail, then it would be obvious that the user or group of users no longer need the e-mail or it's contents taking up space in their "mailbox", therefore, deleting anything attached or associated with the email.

21. Beck teaches wherein providing proof of receipt involves:

22. delivering an encrypted version of the attachment, (e.g. col. 6, lines 13 – 67, "... *attachment 420 may be compressed (to minimize storage space and network bandwidth consumed) and/or encrypted (for privacy) before storing in WWW HTTP server 221 or before being transmitted from WWW HTTP server 221 to a recipient PC's respective WWW HTTP server.*" & col. 7, lines 19 – 40, "...*other encryption techniques may be utilized as well for these and related purposed, such as...digitally signed for authentication purposes*"),

23. receiving a receipt for the encrypted version of the attachment, (e.g. col. 6, lines 13 – 67, "... *attachment 420 may be compressed (to minimize storage space and network bandwidth consumed) and/or encrypted (for privacy) before storing in WWW HTTP server 221 or before being transmitted from WWW HTTP server 221 to a recipient PC's respective WWW HTTP*

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server.” & col. 7, lines 19 – 40, “...other encryption techniques may be utilized as well for these and related purposed, such as...digitally signed for authentication purposes”), and

24. sending the decryption key for the attachment, (e.g. col. 6, lines 13 – 67, “... attachment 420 may be compressed (to minimize storage space and network bandwidth consumed) and/or encrypted (for privacy) before storing in WWW HTTP server 221 or before being transmitted from WWW HTTP server 221 to a recipient PC's respective WWW HTTP server.” & col. 7, lines 19 – 40, “...other encryption techniques may be utilized as well for these and related purposed, such as...digitally signed for authentication purposes”). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Beck with Arnold and what is well known in the art because providing a type of encryption to an email and/or an attachment to an email will ensure that unauthorized users browsing the WWW HTTP servers are unable to obtain a usable copy of the attachment file. Young teach the receipt includes a hash of a encrypted message, (e.g., col. 8, line 47 – col. 9, line 23, “The receiver forms a return receipt packet that consists of a fixed return receipt header, the received message (or the hash of the received message), and additional information.” “If the result matches the ciphertext in the first packet that the original sender sent, then the e-mail key is regarded as authentic. This key is then used to decrypt and obtain the actual information that the original sender sent.”). It would have been obvious to one of ordinary skill in the art, at the time the invention was conceived, to combine Young with the combine system of Arnold and Beck because it would be secure to utilize a encrypted message that can only be deciphered by the sender so a key can be obtained by the receiver to decrypt the message and read what was intended for the receiver. Furthermore, utilizing encryption in messages ensures that only privileged users have the ability to view the

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messages transmitted between them. Eldridge teaches asking a sender of the email message whether to replace the attachment with a reference specifying the location of the attachment, (e.g., col. 7, lines 15 – 40, *“The substitution of secure documents tokens for email attachments can either be performed automatically or manually on a per-document basis.”*);

25. if the sender agrees to replace the attachment,

26. storing the attachment at a location on a communication network from which the attachment can be retrieved, (e.g., col. 7, lines 30 – 58). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Eldridge with the combine system of Arnold, what is well known in the art, Beck and Young because it would be more convenient for a user to have the option to replace the attachment, if there is one present, in the case where the attachment is not going to be a burden on the network, i.e., attachment is not that large.

27. Referencing claim 2, as closely interpreted by the Examiner, Arnold teaches receiving the modified email message at the recipient, (e.g. col. 2, lines 20 – 50); and

28. using the reference specifying the location of the attachment to retrieve the attachment across the communication network, (e.g. col. 2, lines 20 – 50).

29. As per claim 3, as closely interpreted by the Examiner, Arnold, Beck and Young do not specifically teach retrieving the attachment includes authenticating the recipient to a computer system upon which the attachment is stored. Eldridge teaches retrieving the attachment includes authenticating the recipient to a computer system upon which the attachment is stored, (e.g. col.

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5, line 47 – col. 6, line 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Eldridge with the combine system of Arnold, what is well known in the art, Beck and Young because it would be more secure if the user utilized an authentication system in the invention so to keep unauthorized users from accessing attachments that are private in nature.

30. As per claim 4, as closely interpreted by the Examiner, Arnold, Beck and Young do not specifically teach receiving the email message includes receiving the email message at one of,
31. an application residing on a computer system belonging to a sender of the email message;
32. an email server through which the email message is sent;
33. a firewall that protects at least one trusted computer system from communications across the communication network; and
34. a gateway that converts the email message from a first format to a second format.
- Eldridge teaches receiving the email message includes receiving the email message at one of,
35. an application residing on a computer system belonging to a sender of the email message, (e.g. col. 5, line 47 – col. 6, line 64);
36. an email server through which the email message is sent, (e.g. col. 5, line 47 – col. 6, line 64);
37. a firewall that protects at least one trusted computer system from communications across the communication network, (e.g. col. 5, line 47 – col. 6, line 64); and
38. a gateway that converts the email message from a first format to a second format, (e.g. col. 5, line 47 – col. 6, line 64). It would have been obvious to one of ordinary skill in the art at



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the time the invention was made to combine Eldridge with the combine system of Arnold, what is well known in the art, Beck and Young because the system would be more secure if the email were to go through some type of security point to prevent unauthorized email to enter different domains or systems so not to corrupt or damage any system from working, also, if needed, a second format would be needed if different protocols were implemented in the system that the email is being sent to making the system more versatile in accepting different types of network transport formats. Furthermore, having the system with an email server with a user having an application residing on a computer system belonging to a sender of the email message would be more convenient because it is a common practice in email technology.

39. As per claim 5, as closely interpreted by the Examiner, Arnold, Beck and Young do not specifically teach allowing the attachment to be updated at the location on the communication network. Eldridge teaches allowing the attachment to be updated at the location on the communication network, (e.g. col. 17, lines 8 – 16). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Eldridge with the combine system of Arnold, what is well known in the art, Beck and Young because if the attachment is old and newer versions of the attachment were available, it would be more efficient for a system to have an updated version of the attachment incase of important information that was added can be viewed and not missed.

40. Referencing claim 9, as closely interpreted by the Examiner, Arnold teaches wherein the attachment is a file, (e.g. col. 2, lines 20 – 50).

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41. Referencing claim 10, as closely interpreted by the Examiner, Arnold teaches the reference specifying the location of the attachment includes a uniform resource locator (URL), (e.g. col. 3, line 57 – col. 4, line 5).

42. Claims 11 – 15, 19 – 25, 29 and 30 are rejected for similar reasons as stated above.

43. Claims 6, 16 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold in view of what is well known in the art, Beck, Young and Eldridge as applied to claims 1, 11 and 21 above, and in further view of Pollack (6505236) in further view of Trenbeath et al. (6324587) (hereinafter Trenbeath) in further view of Birrell et al. (6092101) (hereinafter Birrell).

44. As per claim 6, as closely interpreted by the Examiner, Arnold, Beck, Young and Eldridge do teach the deletion of attachments, (e.g. col. 2, line 20 – 50), but does not specifically teach deleting the attachment from the location on the communication network after at least one of:

45. an expiration of a time period;

46. sending a notification to recipients of the email message that the attachment is to be deleted;

47. receiving a command to delete the attachment from a sender of the email message; and

48. storing the attachment to archival storage. Pollack teaches deleting the attachment from the location on the communication network after at least one of:

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49. an expiration of a time period, (e.g. col. 2, lines 26 – 57). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pollack with the combine system of Arnold, what is well known in the art, Beck, Young and Eldridge because it would be more efficient if the system had a way to delete information that is old and no longer being used by the user. Pollack does not specifically teach sending a notification to recipients of the email message that the attachment is to be deleted;

50. receiving a command to delete the attachment from a sender of the email message; and

51. storing the attachment to archival storage. Trenbeath teaches sending a notification to recipients of the email message that the attachment is to be deleted, (e.g. col. 9, lines 19 – 35);

52. receiving a command to delete the attachment from a sender of the email message, (e.g. col. 29, line 60 – col. 30, line 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Trenbeath with the combine system of Arnold, what is well known in the art, Beck, Young and Pollack because of similar reasons as stated above.

Trenbeath does not teach storing the attachment to archival storage. Birrell teaches storing the attachment to archival storage, (e.g. col. 1, lines 51 – 59). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Birrell with the combine system of Arnold, what is well known in the art, Beck, Young, Eldridge, Pollack and Trenbeath because if a user needed the information that was old for historic reference then it would be more efficient if the user had an option of storing the attachment in a different location, (i.e. personal folder), so to free up space for other user's attachments that are not old.

53. Claims 16 and 26 are rejected for similar reasons as stated above.

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54. Claims 7, 17 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold in view of what is well known in the art, Beck, Young and Eldridge as applied to claims 1, 11 and 21 above, and in further view of Birrell (6092101).

55. As per claim 7, Arnold teaches the communication network includes at least one of:

56. a computer network, (e.g. col. 3, lines 51 – 56), but does not specifically teach a telephone network. Birrell teaches a telephone network, (e.g. col. 4, lines 26 – 36). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Birrell with the combine system of Arnold, what is well known in the art, Beck, Young and Eldridge because it would be more versatile for a user to utilize the system on a two potentially different types of networks, LANs and dial-up networks. This would make the system more available for users in a work environment or a personal home environment.

57. Claims 17 and 27 are rejected for similar reasons as stated above.

### ***Response to Arguments***

58. Applicant's arguments filed 05/09/2005 have been fully considered but they are not persuasive.

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59. In the Remarks, Applicant argues in substance that the combined system of Arnold, Beck, Yong and Eldridge, either separately or in concert, which suggests requesting permission to replace the attachment with a location for the attachment prior to replacing the attachment.

60. As to part 1, Examiner would like to draw the Applicant's attention to the prior art of Eldridge, in which teaches that the act of replacing the attachment can be done automatically or "manually on a per-document basis". This cited area would leave one to believe that if a sender chooses, they could intervene in the automatic replacement and make a decision as to whether or not to replace the attachment.

61. Examiner would also like to draw the Applicant's attention to the 892 form with reference to the prior art of Tsai (6839741) which also teaches this limitation.

### *Conclusion*

62. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

63. a. Tsai U.S. Patent No. 6839741 discloses Facility for distributing and providing access to electronic mail message attachments.

64. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

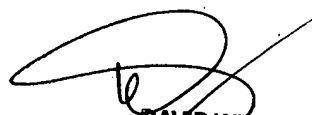
Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 571-272-3912. The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David E. England  
Examiner  
Art Unit 2143

De



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